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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/507,064	03/28/2005	Taizo Kobayashi	10921.247USWO	8905

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EXAMINER

BALL, JOHN C

ART UNIT	PAPER NUMBER
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1795

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07/28/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/507,064	Applicant(s) KOBAYASHI, TAIZO	
	Examiner J. CHRISTOPHER BALL	Art Unit 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 12-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>09/08/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Summary

1. This is the initial Office Action based on the KOBAYASHI application filed with the Office on March 28, 2005, and response to election of species requirement filed with the Office on March 31, 2009.
2. Claims 1-20 are pending and claims 1-11 have been fully considered and examined.

Election/Restrictions

3. Applicant's election of Species I in the reply filed on March 31, 2009, is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
4. Claims 12-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on March 31, 2009.

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5. The Examiner notes that the election put forth examination of claims 1-4, 7, 8, 14, 15, and 17. However, claims 14, 15, and 17 are drawn to a species, specifically Species III, which is distinct from the species encompassed by claims 1-4, 7, and 8, specifically Species I. Therefore, only the claims drawn to Species I, namely claims 1-11 will be examined on the merits.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by LIAMOS et al. (WO 01/33216 A1).

LIAMOS discloses a analyte sensor that has an information recognizing analyzer (p. 3, line 26 – p. 4, line 4) used with an analyzing article (p. 11, line 6-

17) attached thereto (p. 12, lines 9-13), for analysis of a specific component in a sample of liquid supplied to the analyzing article (p. 11, lines 4-5), comprising: an information recognizer (1451 & 1452, Figure 16B) for recognition of information added to the analyzing article (presence or absence of conductor 1450, Figures 16A & 16B; p. 35, lines 5-13), wherein the information recognizer includes an electro-physical-quantity variable part which has different electro-physical-quantities in accordance with the information added to the analyzing article, upon attachment of the analyzing article, in the form of electrical connection between the leads when the insertion monitor contact pad is present (p. 34, lines 11-26; p. 35, line 20 – p. 36, line 2).

8. Claims 1-7 and 9-11 are rejected under 35 U.S.C. 102(e) as being anticipated by LEWIS et al. (US 6,773,671 B1).

Regarding claim 1, LEWIS discloses a multichemistry measuring device, wherein is taught an information recognizing analyzer used with an analyzing article attached thereto (Figures 4 and 5), for analysis of a specific component in a sample liquid (Col. 3, lines 50-59) supplied to the analyzing article (Col. 4, lines 35-37), comprising:

an information recognizer, in the form of a test port with flexible and static pins (Col. 9, lines 54-58; 540 & 580, Figure 5) for recognizing of information added to the analyzing article, in the form of an indicator (522, Figure 5),

wherein the information recognizer includes an electro-physical-quantity variable part, in the form of electrical communication between a flexible pin and static pin (Col. 9, lines 54-58), which has different electro-physical-quantities in accordance with the information added to the analyzing article, upon attachment of the analyzing article (Col. 9, lines 32-49).

Regarding claim 2, LEWIS teaches the electro-physical-quantity variable part includes a pair of a first and second electrode (540 & 580, Figure 5) in relative position relationship variable upon attachment of the analyzing article (Col. 9, lines 45-49).

Regarding claim 3, LEWIS teaches the first and second electrodes have the distance between the two varied, either being bridged (in contact) or not bridged (not in contact) (Col. 6, lines 48-58).

Regarding claim 4, LEWIS teaches at least one of the first and second electrodes in the information recognizer further includes a fixed elastic member, in the form of the flexible pin (540, Figure 5), the distance between the first and the second electrodes being varied by an elastic deformation of the elastic member, as the flexible pin is either made to contact the static pin or no contact is made dependant upon the presence of the indicator (Col. 6, lines 48-58).

Regarding claim 5, LEWIS teaches distance between the first and the second electrodes being varied by an elastic deformation of the elastic member, as the flexible pin is either made to contact the static pin or no contact is made dependant upon the presence of the indicator (Col. 6, lines 48-58), such variability inherently changing the area of mutually opposed surface due to the curve shape of the flexible pin (540, Figure 5).

Regarding claim 6, LEWIS teaches the flexible pin, which is at least one of the first and second electrodes, that moves upon attachment to the analyzing article, as to make contact with the static pin (Col. 6, lines 48-58), wherein the curved shape of the flexible pin will translate some of the motion of the flexible pin in the direction of the insertion of the analyzing article.

Regarding claim 7, LEWIS teaches the electro-physical-quantity variable part includes a pair of a first and second electrode (540 & 580, Figure 5) in relative position relationship variable upon attachment of the analyzing article (Col. 9, lines 45-49), information being recognized individually from each pair of electrodes, in the form of closing a circuit by contacting of the electrodes (Col. 5, lines 42-44).

Regarding claim 9, LEWIS teaches the electro-physical-quantity variable part includes a pressure sensitive electrical conductor, in the form of a flexible pin

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(540, Figure 5), having a resistance value variable upon attachment of the analyzing article (Col. 10, lines 17-27).

Regarding claim 10, LEWIS teaches the electro-physical-quantity variable part includes a pressure sensitive electrical conductor, in the form of a flexible pin (540, Figure 5), having a resistance value variable upon attachment of the analyzing article (Col. 10, lines 17-27); duplication of parts to produce a plurality of pressure sensitive electric conductors has no patentable significance (*In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960)).

Regarding claim 11, LEWIS teaches a resistance value measurer (Col. 10, lines 23-24); and also teaches measuring of an arbitrarily large number of different indicators to indicate a particular type of analyzing article (Col. 10, lines 24-32), which would inherently require comparison between with a predetermined threshold for such an identification to be possible.

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Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over LEWIS et al. (US 6,773,671 B1) in view of KERMANI et al. (US 2003/0098233 A1).

LEWIS teaches the limitations of claims 1, 2, 9, and 11, as outlined above.

LEWIS does not explicitly teach a capacity measurer.

Instant claim 8 and instant claim 11 differ only in that claim 8 recites a capacity measurer and claim 11 recites a resistance value measurer.

KERMANI teaches capacitance and resistance measurements both can be derived from current measures (paragraph [0082]).

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At the time of the present invention, it would have been obvious to one of ordinary skill in the art that one could substitute one known type of measurement, based on capacitance, for another type of measurement, based on resistance, with an expectation of a predictable result (*KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, 82 USPQ2d 1385 (2007)).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. CHRISTOPHER BALL whose telephone number is (571)270-5119. The examiner can normally be reached on Monday through Thursday, 8:00 am to 5:00 pm (EDT).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nam X Nguyen/
Supervisory Patent Examiner, Art Unit 1753

JCB
07/22/2009